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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,134	04/15/2004	ROBERT E. HARMS	9530.48104	3133
<div>22235 7590 06/29/2007 MALIN HALEY AND DIMAGGIO, PA 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316</div>				
			EXAMINER HWANG, VICTOR KENNY	
			ART UNIT 3764	PAPER NUMBER
			MAIL DATE 06/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,134

Applicant(s)

HARMS, ROBERT E.

Examiner

Victor K. Hwang

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


JEROME DONNELLY
PRIMARY EXAMINER

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 and 16-18, drawn to the protective saddle for a dumbbell and the frame for a plurality of dumbbells, classified in class 482, subclass 108.
 - II. Claims 11-15, drawn to method for forming a saddle for a dumbbell, classified in class 482, subclass 148.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as molding entirely out of plastic; and the process as claimed can be used to make another and materially different product, such as a foot hold or hand hold for a climbing apparatus.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Dale Paul DiMaggio on June 25, 2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10 and 16-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The disclosure is objected to because of the following informalities:

in paragraph [0006], line 2, "hand" presumably should be changed to --and--;

between paragraphs [0029] and [0030], a paragraph presumably should be inserted to provide a brief description of Fig. 8;

in paragraph [0036], line 9, "massing" presumably should be changed to --passing--;

in paragraph [0036], last line, "formes" presumably should be changed to --formed--;

and

in paragraph [0046], line 4, "16" presumably should be changed to --100--.

Appropriate correction is required.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "30" and "36" shown in Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37

CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to because in Fig. 2, the reference character "14" does not appear to accurately identify the upper end of vertical element 19; and in Fig. 6, the reference characters "19" and "14" appear to be transposed with one another. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claims 4, 5, 9, 10, 15, 17 and 18 are objected to because of the following informalities:

in claims 4, 5 and 10, the recitation "the surface" is not clear whether the top surface of the curved element of claim 1 or the non-marring surface of claim 1 is being referred to, and presumably it is the non-marring surface that is being referred to;

in claim 9, the recitation "the vertical member" does not have proper antecedent basis and presumably refers to the generally vertical element of claim 1; and

in claim 15, the recitation "the substance" does not have proper antecedent basis and presumably the claim should depend from claim 12 to provide the needed antecedent basis;

in claim 17, the recitation of "a frame" is unclear whether this frame is different than the frame recited in the preamble of claim 16; and

in claim 18, the recitation "the means for attachment" lacks proper antecedent basis and presumably the claims should depend from claim 17 to provide the needed antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8, 10 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bodymasters* (BE 201, 201B & BE227B Dumbbell Racks, Mastering the Art of Fitness brochure, received in the USPTO 1994) in view of *Petrone* (US Pat. 5,954,619) and *Perform Better* (Pro-Style Dumbbell Rack With Saddles, Perform Better 2003 catalog, page 41). *Bodymasters* discloses dumbbell racks, each comprising a frame having a first row of dumbbell saddles to support a first weighted end of a plurality of dumbbells and second row of dumbbell saddles located adjacent the first saddles to support a second weighted end of the plurality of dumbbells. Each saddle comprises a generally U-shaped member including a curved element having a top surface, a base portion and an inner end. A means for attachment can be seen for each saddle comprising an elongated attachment member located in a complementary void in the base portion to securely engage a complementary hole in the frame.

Bodymasters does not disclose a generally vertical element having an upper end and an interior end attached to the inner end of the U-shaped member and is silent as to whether the U-shaped member has a non-marring surface for providing contact with a dumbbell to be placed on the saddle (claims 1 and 16); the non-marring surface is unitary in construction (claim 3); the non-marring surface is injection molded onto the U-shaped member (claim 4); the non-marring surface is sprayed upon the U-shaped member (claim 5); the non-marring surface includes polyurethane (claim 10); and a plurality of means for attachment of the saddle to complementary holes in the frame (claims 2, 17 and 18).

Petrone discloses a pair of dumbbell saddles 50,52 each comprising a top surface and an inner end 156,158. Each saddle further includes gussets 152,154 that are generally vertical

elements having an upper end and an interior end attached to the respective inner end of the saddles to provide strength to the cradles and to aid in ensuring proper positioning of a dumbbell with one of its opposite enlarged ends in each of the cradles. This aids in even distribution of the weight of the dumbbell between the two cradles and ensures that the bar 160 of the dumbbell spans the distance between the two cradles (col. 4, lines 57-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cradles of *Bodymasters* with gussets attached to the inner ends of the saddles, since *Petrone* discloses that gussets provide strength to the cradles, aid in ensuring proper positioning of a dumbbell with one of its opposite enlarged ends in each of the cradles, aids in even distribution of the weight of the dumbbell between the two cradles, and ensures that the bar of the dumbbell spans the distance between the two cradles.

Bodymasters in view of *Petrone* does not disclose that a non-marring surface is located on the U-shaped member.

Perform Better discloses a dumbbell rack with saddles that are encased in rubber to absorb contact from dumbbells. Rubber is considered to be a non-marring material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to encase the dumbbell saddles of *Bodymasters* in view of *Petrone* with rubber, since *Perform Better* teaches that a rubber encased dumbbell saddle absorbs impact from dumbbells.

With regard to claim 10, wherein the non-marring surface includes polyurethane, rubber material is well known in the art to comprise synthetic rubber material that includes polyurethane material. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to use a polyurethane rubber material for the non-marring surface, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With regard to claims 3-5, wherein the non-marring surface is of unitary construction by injection molding onto the U-shaped member or by spraying upon the U-shaped member, the phrase "rubber encased" is taken to mean a core with rubber material surrounding the core. It is well known in the exercise art that encasing a core with rubber material entails surrounding the core with a unitary layer of rubber material. The process of injection molding and spraying are being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, even though *Bodymasters*, *Petrone* and *Perform Better* are silent as to the process used to apply the rubber material, it appears that the product of *Bodymasters* in view of *Petrone* and *Perform Better* would be the same or similar as that claimed.

With regard to claims 2, 17 and 18, wherein a plurality of means for attachment of the saddle to the frame is located in the base portion, duplicating the components of a prior art device is a design consideration within the skill of the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore, it would have been a matter of design choice to provide a second elongated attachment member in the base portion to connect to a second complementary cavity

in the frame. This would provide added strength to the joint between the saddle and the frame and also prevent rotation of the saddle relative to the frame.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Bodymasters* (BE 201, 201B & BE227B Dumbbell Racks, Mastering the Art of Fitness brochure, received in the USPTO 1994) in view of *Petrone* (US Pat. 5,954,619) and *Perform Better* (Pro-Style Dumbbell Rack With Saddles, Perform Better 2003 catalog, page 41) as applied to claim 1 above, and further in view of *Shifferaw* (US Pat. 7,018,325 B2). *Bodymasters* in view of *Petrone* and *Perform Better* discloses the invention as claimed except for the vertical element further comprising a divot for accommodating a handle on the dumbbell.

Shifferaw discloses saddles 13,69 comprising generally vertical elements having an upper end and an interior end attached to ends of a weight support member. The generally vertical elements further comprise divots that accommodate the handle on the weighted bar and also the ends of the weighted bar (see Fig. 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the generally vertical elements of the saddles of *Bodymasters* in view of *Petrone* and *Perform Better* with divots, since *Shifferaw* shows divots to accommodate the handle of the weighted bar.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Segrist et al. (US Pat. 4,666,150), *Ellenburg* (US Pat. 6,123,651), *Polidi* (US Pat. 6,283,898 B1), *Evans* (US Pat. D487,490 S), *Evans* (US Pat. 6,709,370 B1), *Voigt* (US Pat. 6,896,644 B1), *Whetstone* (US Pat. 7,022,053 B2), *Roe* (WO 2006/069421 A1), *Parrillo* (711 – Sectionalized Dumbbell Rack, Parrillo The Hardcore Advantage catalog, page 33, 1995), *Proto Weld* (Dumb Bell Rack #5070, Nebula Fitness Equipment catalog, 1995), *Cybex* (Benches and Racks, Commercial Strength Systems catalog, page 43, 2000) and *TuffStuff* (TuffStuff Plate Trees and Racks, Commercial Strength Equipment: Plate Loaded and Free Weight Systems brochure, 2002) disclose apparatus having features relevant to the claimed invention.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor K. Hwang whose telephone number is (571) 272-4976. The examiner can normally be reached Monday through Friday from 7:30 AM to 4:00 PM Eastern time.

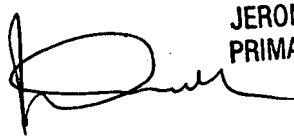
The facsimile number for submitting papers directly to the examiner for informal correspondence is (571) 273-4976. The facsimile number for submitting all formal correspondence is (571) 273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor K. Hwang
June 25, 2007



JEROME DONNELLY
PRIMARY EXAMINER